



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JAN 14 2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314

In re Application of: Yoshikazu KATO : DECISION ON PETITION
Appl. No. 10/656,274 : TO WITHDRAW THE
Filed: September 08, 2003 : OBJECTIONS TO THE
For: INFORMATION PROCESSING : SPECIFICATION
APPARATUS, INFORMATION : UNDER 37 C.F.R 1.181
PROCESSING METHOD, STORAGE :
MEDIUM, AND PROGRAM :
:

This is a decision on applicant's petition under 37 CFR 1.181 filed on October 30, 2009 requesting the withdrawal of the objection to the specification set forth in the final rejection mailed on August 4, 2009.

The petition is **DENIED**.

Applicant argues that the objection on the specification for failing to provide proper antecedent basis for the "means plus function" terms in claim 1 was improper in that "finding clear support or antecedent basis in the description does not require that the exact term recited in the claims be included in the disclosure portion of the specification." Specifically, applicant asserts that support for these terms is clearly found in the disclosure. Applicant also argues that the term "means for" is a term of art and is used to invoke 112, sixth paragraph limitation in a claim.

A review of the file record reveals that the examiner issued a non-final Office action on March 18, 2009 and a final rejection on August 4, 2009 in which the specification was objected to for failing to provide proper antecedent basis for many "means" terms in claim 1 such as "means for receiving", "means for storing", "means for managing", "means for reading", "means for arranging", and "means for composing".

MPEP § 2181 is very clear on the handling of proper antecedent basis for terms used in the specification and states "In the situation in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what structure, materials or acts perform the function recited in a means- (or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly

recites what structure, materials, or acts perform the function recited in the claim element; or (B) state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP § 608.01 (o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element." Since applicant has not pointed to any portion of the specification that shows specifically what structure is used to receive at least one order corresponding to a genre, exactly what structure is used to store the content data corresponding the order, exactly what structure is used to manage a preference data, exactly what structure reads the content data in response to an instruction, exactly what structure arranges the read content data, or what structure serves to compose the arranged content data into a single document for display, the objection to the specification set forth by the examiner is consider proper.

In view of the foregoing facts, the petition is denied.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Andrew Fischer at (571) 272-6779.



Wynn Coggins, Director
Patent Technology Center 3600
(571) 272-5350

Im: 1/12/2010